REMARKS

Claims 1-21 were rejected. Claims 22-42 have been withdrawn from further consideration by the Examiner.

In the interest of clarifying the issues for appeal, claims 5-6, 11-12, and 18-19 have been cancelled. No admission is made thereby, and Applicant reserves the right to pursue like claim coverage in a continuation application.

Claims 1-4, 7-10, 13-17, and 20-21 remain pending in the application.

All remaining claims were rejected as obvious over US Patent 4,902,640 to Sachitano *et al.* ("Sachitano") in view of US Patent 6,441,441 to Suda ("Suda").

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. (*MPEP § 2142; In re Fritch, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992)*). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. (*MPEP § 2142; In re Oetiker, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); In re Piasecki, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984)*). Only when a *prima facie* case of obviousness is established does the burden shift to the Applicant to produce evidence of nonobviousness. (*MPEP § 2142; In re Oetiker, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993)*). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the Applicant is entitled to grant of a patent. (*In re Oetiker, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); In re Grabiak, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985)*).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. (*In re Bell, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993)*). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on the Applicant's disclosure. (*MPEP § 2142*).

The limitations in Claim 1 are not taught or suggested in Sachitano. In particular, as the Examiner notes, Sachitano does not teach or suggest that a base of the double poly bipolar transistor and a gate of the double poly metal oxide semiconductor transistor contain substantially identical dopants, as required by independent Claim 1. The Examiner relies on Suda for this teaching.

Suda describes, variously, a PMOS transistor and an NPN bipolar transistor, and indicates in each case that boron is acceptable as a P-type dopant. Suda does not explicitly teach that these two structures contain substantially identical dopants, and certainly one could be heavily doped while the other is lightly doped.

Even if Suda did include such a teaching as alleged by the Examiner, there is no proper motivation to combine these references. As the Examiner is surely aware, the motivation to combine or modify must be specific to the actual teachings sought to be combined. "In holding

an invention obvious in view of a combination of references, there must be some suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to select the references and combine them in the way that would produce the claimed invention." (*Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1385 (Fed. Cir. 2001) emphasis added). "When the references are in the same field as that of the applicant's invention, knowledge thereof is presumed. However, the test of whether it would have been obvious to select specific teachings and combine them as did the applicant must still be met by identification of some suggestion, teaching, or motivation in the prior art, arising from what the prior art would have taught a person of ordinary skill in the field of the invention." (*In re Dance*, 160 F.3d 1339, 1343 (Fed. Cir. 1998), emphasis added).

The Examiner's alleged motivation is not found anywhere in the art of reference, and nothing in Sachitano or Suda indicate that they are at all concerned with operations as a surface channel device or any particular degradation effects. Nothing in the art of reference, nor in the knowledge generally available to those of skill in the art at the time of the invention, would motivate one to make the specific combination and modification necessary to produce the claimed invention.

As such, Claim 1 distinguishes over Sachitano and Suda, alone and in combination, and the other art of reference. As a result, Claim 1 and dependent Claims 2-4, 7-10, 13-17, and 20-21 are all believed to be allowable.

DOCKET NO. P05792
SERIAL NO. 10/777,012
PATENT

SUMMARY

If any outstanding issues remain, or if the Examiner has any further suggestions for expediting prosecution of this application, the Applicants respectfully invite the Examiner to contact the undersigned at the telephone number indicated below or at *wmunck@davismunck.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Davis Munck Deposit Account No. 50-0208.

Respectfully submitted,

DAVIS MUNCK BUTRUS, P.C.

Date: April 6, 2006

William A. Munck
Registration No. 39,308

Docket Clerk
P.O. Drawer 800889
Dallas, Texas 75380
Tel: (972) 628-3600
Fax: (972) 628-3616
E-mail: *wmunck@davismunck.com*